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| 09/181,547 | 10/29/1998 | KISSEI MATSUMOTO | 286409US6 | 1034 |

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
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ALEXANDRIA, VA 22314

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| EXAMINER |
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CUFF, MICHAEL A

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| ART UNIT | PAPER NUMBER |
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3627

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| NOTIFICATION DATE | DELIVERY MODE |
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03/26/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/181,547 | Applicant(s) MATSUMOTO, KISSEI | |
| | Examiner Michael Cuff | Art Unit 3627 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 52-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 52-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

To clarify the record, the examiner agreed to withdraw the notice of non-responsive amendment if applicant presented why applicant did not change their invention by amending from one apparatus to two apparatus. Claims 1, 2-17, 52-54, and 60 are drawn to the combination of the data sending device 2 and the data receiving device 4 (or more so the portable terminal device 6 part of device 4). Claims 18-28, 55-57, and 61 are drawn to the subcombination of the data receiving device 4. Claims 58 and 59 are drawn to the method of using the receiving device 4. Since applicant has already received an action on both the combination and subcombination, both will be examined and not restricted.

Information Disclosure Statement

The examiner requires copies and translations of Japanese Laying Open Patent H-3-139923 and Japanese Laying Open Patent H-3-13992 cited on page 12 of applicant's specification. From the disclosure, these references show a new music number flag being appended to compressed data. The examiner believes that these are relevant references in regards to applicant's checking for new data step.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

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person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1-28 and 52-61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant claims “and to control said second memory to store only the new content ...” or similar in all independent claims. This is considered to be new matter. From applicant’s page 23, lines 13-14, “... to record only the new musical number data automatically on the hard disc.” This means that at this time only the new music is stored on the hard disc. It does not mean that the new musical number data is the only data stored on the hard disc, which is claimed by the phrase “and to control said second memory to store only the new content ...” To support the examiner’s position see applicant’s specification page 15, lines 9-10; page 16, lines 10-11; and page 17, lines 8-9.

For clarity, the following definition from Webster’s dictionary has been provided.

to record - to cause (as sound, visual images, or data) to be registered on something (as a disc or magnetic tape) in reproducible form.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-28 and 52-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. in view of Galler et al.

Hendricks et al. shows all of the limitations of the claims except for specifying a verifying that data is new content.

Hendricks et al. shows, figure 1, an advanced set top terminal for cable television delivery systems. The system has an operations center 202 (first storage, host side device, first sending/receiving (S/R) unit). The Cable Headend acts as the retrieval unit, decision unit, reproduction unit and the second S/R. Note that the Cable Headend acts as a distribution center and a network controller. The ability to recognize and store data is inherent in these functions. Supplemental data can be provided when user requests more (intent of user). Communication links allow requests and replies to be sent and received. Different audio quality can be achieved upon request (Figure 21 for CD quality audio option). Hendricks et al. also teach subscriber payments (request for payment). Referring to FIG. 22, the advanced system of the set top terminal 220 is used to control video tape machines and simplify recording programs using a

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Guide Record feature. The VCR will be automatically activated to record the selected program (automatic storage of the data received by said second sending receiving means, only data selected will be recorded, appended supplementary data) The selection choice "Press here to return to cable TV" is an indication user is not willing to make payments.

Galler et al. teaches, figure 1, a program verification for cable TV. From column 2, lines 4-6, If the new video content information is not the same as the stored frame, the verification controller once again transmits an error message to the system computer. This is done to better serve the customer.

Based on the teaching of Galler et al., it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the Hendricks et al. system to incorporate the verifying means of Galler et al. in order to better serve the customer.

Response to Arguments

Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection.

Arguments are in regards to the new limitation. The rejection is technically the same grounds, but other areas of the primary reference have been cited to address the new limitations.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cuff whose telephone number is (571) 272-6778. The examiner can normally be reached on 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Cuff/
Primary Examiner, Art Unit 3627

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